

## REMARKS

### I. Drawings

In the office action, the proposed change to Fig. 3 was not entered, but it was stated that the other proposed drawing changes would be given favorable consideration if submitted separately. The other proposed drawing changes, for Figs. 11, 12, 18, 27 and 32 on sheets 5/13, 7/13, 11/13 and 13/13, are being requested herein in separate "Drawings Request 2," such that the objections noted in paragraphs 7-10 should be deemed overcome.

A new proposed change to Fig. 3 is included herewith in Drawing Request 1." In it the elongated apertures are shown diagrammatically by dashed lines for illustrative but not definitive purposes. The depiction of the elongated apertures thus does not indicate any particular size or orientation as diagrammatically shown, and these drawings thus are not new matter but are instead supported by the original claim 9 and page 4, lines 1-3 and page 18, lines 1-3, 13-15.

### II. Indefiniteness

Claim 9 has been rejected under 35 USC 112, second paragraph, apparently on the basis that "elongate hair-capture slots" are not shown in the drawings. It is submitted that the phrase "elongate hair-capture slots" is definite on its face and means slots that are elongate (i.e., longer in one dimension than the other) and that they capture hair. The existence or lack of a drawing of elongate slots is irrelevant as to the definiteness of this term. If there were one or more drawings of elongate slots, they would just be examples of elongate slots, and they would not serve to limit the slots to the particular shape shown and would not make the term any more or less definite than it already is. In any event, Fig. 3, as amended shows elongate slots. The specification also discusses the shapes and sizes of hair-capture apertures at page 17, line 4- page 18, line 15, and mentions, at page 18, lines 1-3, that "maximum and minimum aperture dimensions of, say, 2.0 x 0.2 mm would not be unreasonable for an irregular shaving aperture pattern," thus indicating an elongate aperture, and refers, at page 18, lines 13-15, to an example where "the minimum aperture dimension is likely to be similar to that for a normal shaving

aperture, but apparent length could be in excess of 2.0 mm," thus also indicating an elongate aperture.

Claim 57 has been rejected under 35 USC 112, second paragraph for alleged indefiniteness of the term "stress-free state." The examiner asks: "What is the 'stress-free state' referring to?" Claim 57 recites: "A shaving cutter according to claim 1 wherein said cutter has both the convex elliptic region and the hyperbolic region [sic "region"] when in a stress-free state." The "stress-free state" thus refers to the cutter and means that there is an absence of externally applied stress. If the cutter did have stress, such stress, of course, would be caused by external forces that would tend to cause a deformation or bending. The cutters described in the specification are formed by an electric deposition process on a mandrel into the shape described, rather than being mechanically deformed into such shape, and thus are thus free of stress, i.e., in a stress-free state. Applicants thus submit that this term is definite.

### III. No Anticipation by Pranjko

The Examiner rejected claims 1-17, 50-54, 57 and 58 as being anticipated by Pranjko (DE M9004739.7). We submit, however, that Pranjko fails as an anticipating reference and in addition it does not teach or even suggest some of the specific features introduced by certain of the dependent claims. We will address each of these points separately below.

#### A. Pranjko Fails to Teach the Features of Claims 1, 16 and 17

Contrary to what the Examiner asserts, Pranjko does not disclose the cutter of claims 1, 16 or 17. The Pranjko design registration merely discloses the external, aesthetic look of a fanciful representation of a "Rasierapparat," i.e., a safety-razor, which appears to have a curved grille. Pranjko neither identifies nor describes any of the elements that are shown in his drawing. Furthermore, he says absolutely nothing about how those elements are made, or how they are assembled together, or what lies hidden beneath them. The Examiner, using nothing more than hindsight, is reading details into the reference that are not present.

What Pranjko appears to show is some type of curved grille that extends between two supports. The grille has an outer curved surface on its long side and an inner curved surface on its inner side. But Pranjko presents no written details whatsoever about the nature of the curved

surfaces. More specifically, Pranjko presents no written description that in any way indicates that the either surface is elliptic or that either surface is hyperbolic, as recited in claim 1.

It is appears that both the outer and inner curved surfaces are generally in the shape of an arc, though the precise geometries of the surfaces are unknown. There is no written description anywhere within the Pranjko reference from which one could conclude that:

the first and second surface regions are shaped such that there exists a cross-sectional plane which intersects the first surface region along a first curved line on which the first surface region is concave with a first radius of curvature and which also intersects the second surface region along a second curved line on which the second surface region is convex with a second radius of curvature larger than the first radius of curvature,

as required by claim 16.

Similarly, there is no written description anywhere within the Pranjko reference from which one could conclude that:

a first surface region having two orthogonal planes of curvature, and being concave in one plane; and  
a second surface region having two orthogonal planes of curvature, and being convex in both planes, wherein the first surface region merges seamlessly with the second surface region,

as required by claim 17.

In view of the total absence of a written description of the apparatus shown in the Pranjko reference, it must be the case that the Examiner is implicitly arguing that the Pranjko grille "inherently" anticipates the claims. But if that is the Examiner's argument, the Examiner is ignoring the rather high standard that must be met to justify rejecting a claim as inherently anticipated by a reference. It is basic law that: "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference." Verdegaal Bros. v. Union Oil Co. of Calif., 2 USPQ.2d 1051, 1053 (Fed. Cir. 1987); same, Tyler Refrig. v. Kysor Indus. Corp., 227 USPQ 845, 846-47 (Fed. Cir. 1985). "The identical invention must be shown in as complete detail as is contained in the ... claim." Richardson v. Suzuki Motor Co., 9 USPQ.2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. See In re Bond, 15 USPQ.2d 1566 (Fed. Cir. 1990). For inherency, the Federal Circuit in In re Robertson, 49 USPQ.2d 1949, 1951 (Fed. Cir. 1999) has reiterated the relevant standard: "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is

not sufficient." (emphasis added); (quoting In re Oelrich, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981); same, Electro Medical Sys., S.A. v. Cooper Life Sciences, Ind., 32 USPQ.2d 1017, 1020 (Fed. Cir. 1994). Inherency requires that two conditions be met: first, the feature asserted to be "inherent" must be "necessarily present in the thing described in the reference, and secondly, that it would be so recognized by persons of ordinary skill." Robertson, 49 USPQ.2d at 1950-51; same Electro Medical Sys., 32 USPQ.2d at 1020.

Moreover, the Examiner must be careful in drawing inferences about precise details of general shapes from drawings alone. The M.P.E.P. at §2125 cautions against improper inferences being drawn from drawing figures. While use of drawings is not completely impermissible in certain limited situations, §2125 states in boldface capitals "**PROPORTIONS OF FEATURES IN A DRAWING ARE NOT EVIDENCE OF ACTUAL PROPORTIONS WHEN DRAWINGS ARE NOT TO SCALE**", and explains: "When the reference does not disclose that the drawings are to scale and is silent as to dimensions, arguments based on measurements of the drawing features are of little value." Same, see In re Chitayat, 161 USPQ 224, 226 (C.C.P.A. 1969) (claim to higher quality fiber-optic transmission reciting image displacement of at least 100 fiber diameters, where the cited drawings according to the Solicitor allegedly showed 45 nutations but lacked an explicit numerical teaching relating image displacement to fiber diameter, Court stated "Patent drawings are not working drawings and this argument is predicated, moreover, on a greatly enlarged section of a small drawing obviously never intended to show the dimensions of anything. We do not find it persuasive." (quoting In re Wilson, 136 USPQ 188, 192 (C.C.P.A. 1963) (emphasis added)). Any attempt to use the figures to infer precise details about what are only represented as general shapes fails to satisfy the preponderance of the evidence standard required to make a rejection based thereon, and it should be withdrawn.

Applicants have reviewed the sole case relied upon by Examiner, In re Mraz, 173 USPQ 25 (CCPA 1972), and find it distinguishable from the present facts. In Mraz, the claim on appeal was directed to the shape of a deburring roller for deburring sheet metal strips, and included the limitation of a groove whose inclined surface was at an angle in a range "not exceeding 15°". The claim was rejected on the figures of a utility patent to Wilson in which the rollers had a V-shaped groove at an angle measuring 6°, whose fabrication was a straightforward matter conventionally known in the art, and thus the prior art angle lay within the claimed range. In

contrast to the present issue, the prior art angle was a simple, one-dimensional, scalar quantity measurable in one plane. While it is a truism that a clear showing in a drawing is not disregarded, the Court in Mraz emphasized that the reason for its decision was that the figure "in the Wilson reference focuses on the edge angularity well within the range recited in appellant's claims", 173 USPQ at 27. The sole issue on the figures in Mraz was answered by the simple inquiry whether one V-shaped opening was bigger than another. The Mraz case does not apply to the present facts since there is no focus of the Pranjko figures on the features recited in the present claims, thus there is no clear showing.

B. Pranjko Is Not An Enabling Reference

More importantly, however, Pranjko is not an enabling reference because Pranjko fails to teach how to fabricate any of the illustrated elements. Simply showing a device or structure does not establish that a person skilled in the art could make it.

Furthermore, the Examiner has not supplied any other evidence to the effect that a person of ordinary skill in the art of shaving cutters would have been able to fabricate a cutter having the complex, but unscaled and wholly unspecified, curvature shown in Pranjko without undue experimentation. Indeed, we submit that such skill did not exist in the prior art. Thus, Pranjko does not provide an enabling disclosure.

The law requiring that a reference must be enabling in order for it to be a valid anticipatory reference is clear. The Federal Circuit has repeated this principle many times. For example:

It is well settled that prior art under 35 U.S.C. §102(b) must sufficiently describe the claimed invention to have placed the public in possession of it. Such possession is effected if one of ordinary skill in the art could have combined the publication's description of the invention with his own knowledge to make the claimed invention. Accordingly, even if the claimed invention is disclosed in a printed publication, that disclosure will not suffice as prior art if it was not enabling. [emphasis added] In Re Donohue, 766 F.2d 531, 533 (Fed. Cir. 1985).<sup>1</sup>

In another case, the court wrote:

A rejection for anticipation under section 102 requires that each and every limitation of the claimed invention be disclosed in a single prior art reference. In addition, the reference must be enabling and describe the applicant's claimed invention sufficiently to have placed it in the

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<sup>1</sup> Copy of case accompanies this response.

possession of a person of ordinary skill in the field of the invention. [emphasis added] In Re Paulsen, 30 F.3d 1475, 1478 (Fed. Cir. 1994).<sup>2</sup>

This requirement is most often stated in connection with the technical arts that are viewed as being unpredictable, e.g. chemical cases. It is not, however, limited to only to chemical cases or to the unpredictable arts. As indicated by another more recent Federal Circuit court decision, it also applies to the mechanical arts.

A recent case involving a method for securing two or more wythes (i.e., layers of masonry) is particularly instructive. The claimed invention, which was owned by Halifix Ltd., involved dry fixing or tying one masonry layer to another masonry structure. The single method claim included twelve elements among which were three that related to the operation of a tool that was needed to effect the anchoring of a tie into one of the masonry layers without creating any stress such as might be caused by hammering the tie into place.

Halifix brought a suit against Blok-Lok, Ltd. alleging that the company was infringing its patent. Blok-Lok defended by arguing that the patent was invalid because Halifix had disclosed the invention in a brochure which Halifix had distributed to the public in 1993, which was more than one year prior to filing its patent application. The 1993 brochure described Halifix stainless steel ties and their use in masonry refacing and new construction and it described the use of the ties in both "DryFix" and "Dry-Chemical Fix" methods of construction.

Halifix acknowledged that the brochure taught nine elements of the claim but argued that the three elements which related to how the tool operated were not taught. The court noted that:

The brochure might nevertheless be anticipating if a person of ordinary skill in the art would understand the brochure as disclosing elements (8)-(10) and if such a person could have combined the brochure's description of the invention with his own knowledge to make the claimed invention. Halifix Ltd. v. Blok-Lok, Ltd., 208 F.3d 1339, 1347 (Fed. Cir. 2000)

Halifix argued that the tool required to perform the missing steps was not available at the time that the brochure was made public. Blok-Lok failed to submit any evidence that such a tool was available or that a person skilled in the art would know how to make one in view of the 1993 brochure. The court decided that the 1993 brochure did not anticipate the method claim and stated:

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<sup>2</sup> Copy of case accompanies this response.

We conclude, on the record before us, that Blok-Lok failed to provide clear and convincing evidence that the '93 brochure enables a person of ordinary skill in the art to practice the claimed method. In particular, Blok-Lok did not present any evidence indicating that a person of ordinary skill in the art could have made or obtained a tool capable of being used in the claimed method without an undue amount of experimentation. Halifax Ltd. v. Blok-Lok, Ltd., 208 F.3d 1339, 1348 (Fed. Cir. 2000)<sup>3</sup>

Applying that standard to the present case, given that there is no evidence of record that a person of ordinary skill in the art could make the Pranjko "cutter," we submit that the Pranjko reference is not an enabling reference and thus fails to anticipate the claimed invention.

The claimed shaving cutter is a complex shape that in the case of the shaving cutter of claim 1 includes convex elliptic and hyperbolic regions<sup>4</sup>. Though it might be easy to visualize that structure, it is not easy to fabricate it.

The present application discloses and describes in detail an electroforming technique that makes it possible to fabricate the complex curvature of the claimed cutter. The disclosed electroforming technique, which uses a mandrel, is the subject of other claims that were the subject of a restriction requirement issued by the Examiner. In other words, that technique is not part of the prior art.

The application does discuss other prior art fabrication techniques and points out their deficiencies for the purpose of constructing cutters having complex curvatures:

Conventional shaving foils for oscillatory dry shavers almost invariably provide only parabolic surfaces. An exception is JP-A-7-646...which describes a foil having an elliptic surface. A base member is formed by applying resist to a flat sheet of metal, patterning the resist and then deforming the metal sheet by a drawing process to form an elliptic surface. The method is limited by the fact that excessive deformation of the initially flat sheet could cause cracking of the resist layer. (Page 1, line 34 to page 2, line 7).

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<sup>3</sup> Copy of case accompanies this response.

<sup>4</sup> Claims 16 and 17 recite the complex nature of the curved surfaces in different ways. Claim 16 defines the curvature in the following way:

wherein the first and second surface regions are shaped such that there exists a cross-sectional plane which intersects the first surface region along a first curved line on which the first surface region is concave with a first radius of curvature and which also intersects the second surface region along a second curved line on which the second surface region is convex with a second radius of curvature larger than the first radius of curvature.

And claim 17 defines it as follows:

a first surface region having two orthogonal planes of curvature, and being concave in one plane; and  
a second surface region having two orthogonal planes of curvature, and being convex in both planes,  
wherein the first surface region merges seamlessly with the second surface region.

And the application further notes about prior art electroforming techniques:

It has previously been difficult to electroform complicated surfaces having non-zero Gaussian curvature, although attempts have been made to use photolithography to expose a photoresist through a photo-imaging mask. However, conventional photoresists are usually applied as a liquid and therefore allow little or no control over the localized continuity of the photoresist. Whilst this may be satisfactory on a two-dimensional, flat surface, it causes difficulties if the photoresist is applied to a complex three-dimensional shape. Current dry film photoresist is not suited to application onto complex shaped surfaces. (Page 13, lines 9-19).

The Examiner has not identified any technique which would have been known by a person of ordinary skill in the art of shaving cutters or foils and which such a person would have recognized could be used to make a cutter having the complex form of Pranjko's "foil cutter." Indeed, we submit that no such technique existed in the prior art. Thus, without the teaching of the present invention, the skilled person would not have known how to fabricate a cutter having the shape disclosed by Pranjko without undue experimentation.

It should be noted that we are not arguing that a design patent can never be an anticipating reference. We acknowledge that under the appropriate circumstances, not present here, it can serve that purpose. In this case, we are only pointing out that to meet the standard of an anticipating reference, the design patent must also be enabling. In the case of the Pranjko design patent that provides no description whatsoever regarding method of making, it is permissible for the Examiner to point to other teaching outside of the reference to satisfy the enablement requirement. The Examiner, however, has not identified any prior art that enables the Pranjko device. In fact, we submit that no such teaching exists in the prior art before the date of the present application. Without the teaching found in the present application regarding a method of making complex three dimensional cutter foils, a person skilled in the art would not have been motivated to fabricate a cutter having the complex convex elliptic and hyperbolic regions recited in claim 1 let alone a cutter that also includes any of the additional complex curved surfaces recited in claim 5, in claim 6 or in claim 10.

C. Pranjko Fails to Teach the Features of the Claims 5, 6 and 10

The Examiner has also rejected claims 5, 6 and 10 as anticipated by Pranjko. But he has not pointed to any features of Pranjko that teach the limitations required by those claims. Indeed, as explained below, the Pranjko "cutter" does not include those features.



Claim 5 recites that the cutter also includes a "concave parabolic skirt region." This region is illustrated by region 114 in Fig. 1. Claim 6 recites that the cutter also includes a "convex parabolic skirt region." This region is illustrated by region 115 in Fig. 2. That is, it is the skirt region in Fig. 2, which is on the opposite side of the cutter from region 114. And claim 10 recites that the cutter also includes "a pair of convex elliptic end cheeks each merging smoothly with the elliptic and hyperbolic regions." The end cheeks are illustrated by regions 112 and 113 in Fig. 1.

Pranjko does not teach or suggest a cutter that also has a parabolic skirt region. If the Examiner is assuming that the center region is Pranjko's "cutter" that satisfies the requirements of claim 1, it is clear from Pranjko's figures that his "cutter" does not include a parabolic skirt region, either convex or concave, nor does his "cutter" include a pair elliptic end cheeks. It might be true that Pranjko's shaver body extends down from his "cutter" and might define region that the Examiner might analogize to parabolic surfaces. Those parabolic surfaces, however, are not part of Pranjko's "cutter;" rather, they are part of the shaver unit body. Similarly, it might also be true that Pranjko's shaving unit has rounded ends that bound either side of Pranjko's "cutter" and that the Examiner might analogize these to elliptic end regions. But again those rounded ends are not part of the central cutter; rather, they are part of the shaving unit and they define the region between which Pranjko's cutter is mounted.

Moreover, the Examiner has provided no support whatsoever for concluding that a person of ordinary skill in the art would be motivated to include those bounding surfaces as part of Pranjko's "cutter" or to extend Pranjko's "cutter" to include such surfaces. Indeed, one skilled in the art would not be motivated to modify the Pranjko cutter in the manner required by claim 5, claim 6, or claim 10, since a cutter so modified would not fit on the shaver unit body that is taught by Pranjko. In addition, eliminating the rounded ends shown on the Pranjko apparatus would eliminate support for the "cutter" that bridges between the two rounded ends. Furthermore, this would wholly rearrange the visual elements of Pranjko's design and totally alter, indeed destroy, the aesthetic look that is the sine qua non and the singular teaching of the Pranjko reference.

A shaving cutter having the features of claims 1 and 5 or the features of claims 1 and 6 are described in the application as having the following advantages:

...the shape provides a contour of continually varying surface curvature which provides planar, concave and convex shaving surfaces, this offering an improved ability to match the contours of the body, especially in difficult areas such as underarm, legs, neck, jawbone and upper lip, and giving an improved shaving performance. (page 7, line 31 to page 8, line 5)

The Examiner has provided no prior art indicating that a person skilled in the art appreciated that those advantages would result from including such features to the cutter itself.

Moreover, the Examiner has not pointed to any prior art that teaches a method of making a cutter that has a convex elliptic region, a hyperbolic region, and a pair of convex elliptic end cheeks merging smoothly with the elliptic and hyperbolic regions.

We wish to remind the Examiner that the burden which must be met to establish that the features of claims 5, 6 or 10 are obvious modifications to Pranjko's "cutter" is not insubstantial. It cannot be met by conclusory statements:

Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." In re Dembiczak, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999).<sup>5</sup>

The Federal Circuit has further cautioned that:

...in the case of less technologically complex inventions, where the very ease with which the invention can be understood may prompt one "to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher."

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Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability - the essence of hindsight. In re Dembiczak, 50 USPQ 2d 1614, 1617 (Fed. Cir. 1999). (citations omitted)

In other words, one must exercise special care in not letting hindsight influence the obviousness question. There must be a rigorous showing of the reasons why one of ordinary skill in the art would have modified the reference in the manner proposed. So, it would not be sufficient to simply argue that the claimed features are design choices.

For the same reasons as those presented above, we also submit that Pranjko fails to teach or render obvious a cutter having the features recited in claims 11 and 50. Claim 11 recites the two "convex elliptic end zones" which merge smoothly with first and second regions. Claim 50 recites a central shaving region and "at least one convex elliptic end zone merging smoothly with the central shaving region."

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<sup>5</sup> Copy of this case accompanies this response.

D. Pranjko Does Not Anticipate Claim 57

Claim 57 depends on claim 1 and adds the feature that the "cutter has both the convex elliptic region and the hyperbolic region when in a stress-free state." This is an inherent result of the process by which the cutter is fabricated according to the specification. As pointed out above, the Pranjko reference contains virtually no description whatsoever so it does not teach that the grille possesses this feature. Moreover, it cannot be legitimately argued that the Pranjko grille inherently possesses this characteristic since it is easy to imagine that the grille piece is flat in its unmounted state. Indeed, the foils in the prior art are of the type that they are flat in their relaxed state and only take on the curved form when mounted in an appropriate frame, as conventionally shown e.g. in U.S. Pat. 4,493,149 (Tanahashi) of record.

IV. Claims 18, 19, 38, 39, 42, 43, 46, and 47 Not Obvious over Pranjko in view of Packham

The Examiner rejected claims 18, 19, 38, 39, 42, 43, 46, and 47 under 35 U.S.C. §103(a) as being unpatentable over Pranjko in view of Packham (GB 2 036 631). The Examiner argues that Pranjko inherently discloses the undercutter required by the rejected claims and alternatively that Packham teaches the shaving system that can be used under the grille shown by Pranjko.

The Examiner's inherency rejection fails to meet the standard required for such rejections. As we have argued above, an inherency rejection requires that the undisclosed features which the Examiner is trying to infer as being present in the disclosed structure must necessarily be present. It is not sufficient to that the undisclosed structure probably is present. And it is certainly not sufficient if other alternative arrangements of equal or higher probability might be present.

In this case, there is no way in knowing what kind of undercutter, if any, is present in the structure shown by Pranjko. It could be a small oscillating structure that moves back and forth from side to side under the grill; it could be a rotating structure that spins about a longitudinal axis of the curved grille; or it could be some other arrangement for providing the shearing or cutting action. In addition, it could be possible that the undercutter(s) need not conform with the

outer cutter. Because there is no way of knowing which possibility might be used and since some of the options do not involve either the "oscillatory movement" or the conforming relationship, as required by claims 18, 38, 42, and 46, Pranjko alone does not support an anticipation rejection of those claims.

With regard to Packham, we note that the undercutter taught by that reference (see transversely slotted cutter section 13) would not work with the element in the Pranjko apparatus that the Examiner has identified as the outer cutter. The undercutter is a straight linear arrangement that would not conform to and thus would not work with the curved outer cutter of Pranjko. Moreover, there is no indication in any of the references regarding how a person might modify cutter section 13 so that it could work within the "shaver" shown by Pranjko. Because of this fundamental mismatch, a person skilled in the art would not be motivated to combine the drive section of Packham with the outer cutter arrangement of Pranjko.

We note that claims 19, 39, 43, and 47, each recite that "the outer cutter has an arcuate longitudinal centre line and the undercutter is correspondingly arcuate." As pointed out above, Pranjko does not and cannot suggest the arcuate center line of the undercutter. The inner workings of the Pranjko structure are completely hidden. And the Packham reference does not teach or suggest a correspondingly arcuate undercutter; rather it teaches a straight linear undercutter.

V. Claims 18, 19, 38, 39, 42, 43, 46 and 47 not Obvious over Pranjko in view of Furuichi

The Examiner rejected claims 18, 19, 38, 39, 42, 43, 46 and 47 under 35 U.S.C. §103(a) as obvious over Pranjko in view of Furuichi. The Examiner argues that Pranjko inherently discloses the undercutter required by the rejected claims and alternatively that Packham teaches the shaving system that can be used under the grille shown by Furuichi.

The Examiner's inherency rejection fails to meet the standard required for such rejections. As we have argued above, an inherency rejection requires that the undisclosed features which the Examiner is trying to infer as being present in the disclosed structure must necessarily be present. It is not sufficient to that the undisclosed structure probably is present.

And it is certainly not sufficient if other alternative arrangements of equal or higher probability might be present.

In this case, there is no way in knowing what kind of undercutter, if any, is present in the structure shown by Pranjko. It could be a small oscillating structure that moves back and forth from side to side under the grille; it could be a rotating structure that spins about a longitudinal axis of the curved grille; or it could be some other arrangement for providing the shearing or cutting action. In addition, it could be possible that the undercutter(s) need not conform with the outer cutter. Because there is no way of knowing which possibility might be used and since some of the options do not involve either the "oscillatory movement" or the conforming relationship, as required by claims 18, 38, 42, and 46, Pranjko alone does not support an anticipation rejection of those claims.

With regard to Furuichi, we note that the undercutter 3 taught by that reference would not work with the element in the Pranjko apparatus that the Examiner has identified as the outer cutter. The undercutter 3 of Furuichi would not conform to and thus would not work with the curved outer cutter of Pranjko. Moreover, there is no indication in any of the references regarding how a person might modify Furuichi's undercutter 3 so that it could work within the "shaver" shown by Pranjko. Because of this fundamental mismatch, a person skilled in the art would not be motivated to combine the drive section of Furuichi with the outer cutter arrangement of Pranjko.

We note that claims 19, 39, 43, and 47, each recite that "the outer cutter has an arcuate longitudinal centre line and the undercutter is correspondingly arcuate." As pointed out above, Pranjko does not and cannot suggest the arcuate center line of the undercutter. The inner workings of the Pranjko structure are completely hidden. And the Furuichi reference does not teach or suggest a correspondingly arcuate undercutter; rather it teaches a straight linear undercutter.

#### VI. Claims 55-56 not Obvious Over Pranjko

The Examiner rejected claims 55-56 under 35 U.S.C. §103(a) as obvious over Pranjko. In support of his rejection, the Examiner states that

...it would have been obvious to the ordinary artisan at the time of the instant invention to provide the device of Pranjko with the same material regions in order to facilitate ease of manufacture due to the same material being used to produce the same...

However, as we argued above, there is no ease of manufacture. Indeed, the Examiner has not presented any evidence that it was even known to a person of ordinary skill in the art of shaving cutters how to fabricate the claimed shaving cutter, whether or not it was integrally formed.

#### VII. There is No Double Patenting Here

Claims 1-7, 16, 17, 57 and 58 stand “rejected under 35 USC 101 for as claiming the same invention as that of claim 1 of prior” U.S. Patent No. Des. 430,352 and U.S. Patent No. Des. 428,671. In the office action the Examiner stated that MPEP §1504.06 (II), which had been cited in our prior response, did not apply because it “deals with nonstatutory double patenting rejections in design-utility situations. That’s not the issue here. The issue is a statutory one wherein the claimed invention is not patentably distinct from the design patents and both the current application and the design patents have the same inventive entity.”

Applicants point out that MPEP §1504.06 Section I explains that: “A design-utility ‘same invention’ double patenting rejection is based on judicial doctrine as there is no statutory basis for this rejection because neither 35 U.S.C. 101 nor 35 U.S.C. 171 can be applied against both claims.”, citing In re Thorington, 163 USPQ 644 (CCPA 1969).

It would appear that, in any event, the examiner is asserting a “same invention” standard. MPEP 804 at 800-20 (rev. August 2001) states, with respect to the same invention standard under 35 USC 101: “A reliable test for double-patenting under 35 U.S.C. 101 is whether a claim in the application could be literally infringed without infringing a corresponding claim in the patent.”, citing to In re Vogel, 164 USPQ 619 (CCPA 1970), the very same case that Examiner cited in support of his argument. In re Vogel states that if there is an embodiment of the invention that falls within the scope of one claim, but not the other, then identical subject matter is not defined by both claims and statutory double patenting would not exist.

In our case, the design patents claim “the ornamental design for a shaving part for shaver, as shown and described” in the drawings of the design patents. Claim 1 of this pending utility

patent application claims "a shaving cutter comprising a skin-engaging surface having both a convex elliptic region and a hyperbolic region." It is clear that the claim of this application could be literally infringed by a device that has a convex elliptic region and a hyperbolic region but looks radically different than the ornamental designs shown in the figures of the design patents such that the device would not infringe those design patents. Accordingly, the rejection for claiming the same invention as the design patents should be withdrawn.

Applicants further note that an obviousness-type double patenting rejection also would not proper. The Patent Office must apply the two-way test prescribed by the Federal Circuit because the design-utility double patenting doctrine is solely a creation of that court, as there is no statutory basis for this rejection since neither 35 U.S.C. §101 (utility patents) nor 35 U.S.C. §171 (design patents) can be applied against both claims. Applicants wish to make the following points in this regard:

1. The Federal Circuit Requires a Two-Way Test (e.g., In re Dembiczak).
2. The 430,352 and 428,671 Design Patents Are Not Obvious over the Utility Claims.

1. The Two-way Test is Required in the Design-Utility Double Patenting Context

The rejection is contrary to the Federal Circuit's requirement for a **two-way** obviousness test in design-utility situations recently re-stated in In re Dembiczak, 50 USPQ.2d 1614, 1619 (Fed. Cir. 1999). The Federal Circuit has long required the two-way test since its earlier decision in Carmen Indus., Inc. v. Wahl, 724 F.2d 932, 220 USPQ 481, 487 (Fed. Cir. 1983). The M.P.E.P. at §1504.06, II., page 1500-33 (rev. July 1998) takes the same position in utility-design situations, requiring the two-way obviousness determination. Furthermore, a rejection under the obviousness-type double patenting doctrine is a question of law that is freely reviewable on appeal. Dembiczak, 50 USPQ.2d at 1619; In re Goodman, 11 F.3d 1046, 29 USPQ.2d 2010, 2015 (Fed. Cir. 1993). The double patenting challenge must be articulated and evaluated, like any other obviousness rejection, against each and every claim individually. Ortho Pharm. Corp. v. Smith, 959 F.2d 936, 22 USPQ.2d 1119, 1124 (Fed. Cir. 1992). As stated in Dembiczak, obvious-type double patenting is only found in rare cases between design and utility patents. Id. at 1619. In applying the two-way test, "there is a heavy burden of proof on one seeking to show

double patenting." Carmen Indus., Inc. v. Wahl, 724 F.2d 932, 220 USPQ 481, 487 (Fed. Cir. 1983).

The present rejection cannot stand for at least the reason that the Examiner has only applied a one-way test, and neither of the cited design patents is obvious over the pending utility claims, so without this finding a proper *prima facie* rejection cannot be made.

Under the two-way test required in utility-design patent situations and articulated in Dembiczak, the rejection "is appropriate only if the claims of the two patents cross-read, meaning that 'the test is whether the subject matter of the claims of the patent sought to be invalidated would have been obvious from the subject matter of the claims of the other patent, **and vice versa**.'" Id. at 1619 (emphasis added). Both prongs of the test must be met or the rejection fails. In Dembiczak, the Federal Circuit held that the utility claims to a plastic lawn refuse bag that had facial features printed on it, allowing the bag when filled with leaves to resemble a Halloween jack-o'-lantern pumpkin, could not be subject to the rejection since Dembiczak's design patent depicting a bag with a jack-o'-lantern face was not obvious over the claims to the mechanical structure.

## 2. The Design Patents Are Not Obvious over the Utility Claims.

The Examiner has not addressed this required prong of the test at all, as discussed above.

Applicants point out that an obvious-type double patenting rejection, like any other obviousness rejection, must be made out having regard to the Graham factors, may not use hindsight, and further may not apply Applicant's own disclosure or figures in the utility application against the design patents, but rather may apply only the text of the claims.

In applying this prong of the two-way test, the Federal Circuit in Dembiczak re-stated the well-known requirement that: "In order for a design to be unpatentable because of obviousness, there must first be a basic design reference in the prior art, the design characteristics of which are 'basically the same as the claimed design.'" Dembiczak at 1619, citing In re Borden, 39 USPQ.2d 1524, 1526 (Fed. Cir. 1996). It is only the claims and not the disclosure or figures of the utility application that can be considered with respect to the design patent, since the disclosure of the "reference" patent may not be used as prior art. Carmen Indus., 220 USPQ at 487; accord, Dembiczak, at 1619; M.P.E.P at §804 II.B.1, at p. 800-18 (rev. July, 1998). Indeed,



the M.P.E.P. at §1504.06 (page 1500-31) specifically requires "The Examiner must be able to recreate the design claimed from the utility claims without any reliance whatsoever on the design drawings." (emphasis added).

Just as with passages quoted by the Board from Dembiczak's utility claims, which the Federal Circuit held "is not a design reference that is 'basically the same as the claimed design'" Id.<sup>6</sup>, the words of Applicants' present utility claims also do not constitute a design reference which is "basically the same as" the claimed design. Simply stated, the pending claims of the utility patent would allow various embodiments whose ornamental appearances are quite different. In that regard the Federal Circuit in Dembiczak stated:

The position adopted by the Board –that a textual description of facial indicia found in the claims of the utility patent application makes obvious the specific designs claimed in the ... Dembiczak design patents– would presumably render obvious, or even anticipate, all design patents where a face was depicted on a bag. But this, of course, is not the law ... . 50 USPQ.2d at 1620.

In our case, one reading the utility claims could come up with a wide variety of designs that do not have the ornamental features of the design patents. Thus the ornamental designs claimed in the design patents are not obvious over the utility claims.

Moreover, in Dembiczak, the applicant therein had two distinct design patents whose embodiments came within the scope of the utility claims on appeal, and that was mentioned by the Court as a further example that the text of the claims of the utility patent is not a reference "basically the same as the claimed design" so that it does not render the design patent obvious. There is a parallel here to the facts in Dembiczak. Likewise, the '352 and the '671 Designs are distinct, and one of ordinary skill starting from the claims of the utility patent, without the benefit of hindsight and who is not allowed to rely on the design drawings (as M.P.E.P. §1504.06 mandates as discussed above), would not know what kind of ornamental appearance to utilize and would not be motivated to arrive at either the design of the '352 or the '671 Design claims.

For all the above reasons, since the design patents are not obvious over the present utility claims, the two-way test is not met, and the rejection should be withdrawn.

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<sup>6</sup> The utility claim appears in the case at page 1615 and clearly describes the facial indicia applied to the trash bag.

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Attached is a marked-up version of the changes being made by the current amendment.

Applicant asks that all claims be allowed. Enclosed is a \$400 check for the Petition for Extension of Time fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: Dec 5, 2000

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**Version with markings to show changes made**

In the specification:

Paragraph beginning at page 22, line 19 has been amended as follows:

5.2 As shown in Fig. 32, develop the mandrel pattern in "Developer"™ 341 [while stirring with a stirrer 342 and] at 20-50°C, preferably 26°C until the aperture pattern is just visible; note the time taken and continue the [immersinio] immersion for the same period. (The figure also shows stirrer 342).

In the claims:

Claim 57 has been amended as follows:

--57. (Amended) A shaving cutter according to claim 1 wherein said cutter has both the convex elliptic region and the hyperbolic [reqion] region when in a stress-free state.--